

1614



PATENT
Customer No. 22,852
Attorney Docket No. 08647.0002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Joseph P. STEINER *et al.*) Group Art Unit: 1614
)
Serial No.: 09/805,249) Examiner: Vickie Y. Kim
)
Filed: March 14, 2001)
)
For: ROTAMASE ENZYME ACTIVITY)
INHIBITORS)

RECEIVED
DEC 04 2003
TECH CENTER 1600/2900

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In the restriction requirement mailed September 5, 2003, the Examiner withdrew the prior restriction requirement mailed March 21, 2003, and newly required restriction under 35 U.S.C. § 121 between the following allegedly patentably distinct groups of claims:

Group I: claims 1-4, 6-7, 12-14, 25-26, 28-29, 33-34, and 36-37 drawn to a method of treating a neurological activity in an animal comprising administering to said animal an effective amount of a compound of formula I; and

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Group II: claims 1, 11, 41-42, and 44-45 drawn to a method for stimulating neurite outgrowth by a nerve cell comprising administering to said nerve cell an effective amount of a compound of formula I.¹

In response, Applicants elect to prosecute Group II, now comprising claims 1, 11, 41-42, and 44-45, without traverse. Applicants further note that claim 1 is a member of both Groups I and II, and is therefore a linking claim as described in M.P.E.P. § 809.03. Accordingly, the restriction requirement between the linked inventions should be subject to the nonallowance of claim 1. See M.P.E.P. § 809.03. Upon allowance of claim 1, the requirement for restriction between Groups I and II should be withdrawn and all of the claims should be examined. See *id.*

Furthermore, it appears that the Examiner has withdrawn the requirement that Applicants elect for examination a single species within the genus of Formula I. (Restriction Requirement mailed September 5, 2003, page 4.) According to the Examiner, Applicants' traversal of the election of species requirement in their Response to Restriction Requirement filed June 13, 2003, included an admission that the species within the genus of Formula I were not patentably distinct. (Restriction Requirement mailed September 5, 2003, page 4.) In response to the Examiner's comments, Applicants note that they did not admit that the individual species within Formula I are not patentably distinct. Rather, Applicants based their traversal of the election of species requirement on the observation that the Office has already issued claims that encompass the genus of Formula I. That is, it is the Office that considers the species of this genus to be patentably indistinct. Such a statement does not constitute an

¹ Applicants note that although the Office Action refers to compounds of formula II, the pending claims are directed to methods of using compounds of formula I.

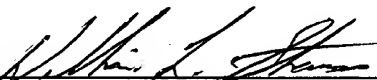
admission on the part of the Applicants that the species within Formula I are not patentably distinct.

By virtue of the three-month period for reply set by the Examiner, this response is timely filed. Should any extensions of time be required to enter this response, please charge the required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 4, 2003

By: 
William L. Strauss
Reg. No. 47,114

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com